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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,318	11/25/2003	Murtuza Lokhandwalla	135858	9461
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EXAMINER				
CHENG, JACQUELINE				
ART UNIT		PAPER NUMBER		
3768				
NOTIFICATION DATE		DELIVERY MODE		
10/30/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/723,318

Applicant(s)

LOKHANDWALLA ET AL.

Examiner

JACQUELINE CHENG

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 17, 2008 have been fully considered but they are not persuasive. The examiner agrees that with the applicant that neither Williams (US 4,885,827) nor Zhang (US 2004/0090334 A1) is analogous to the medical imaging art, however this does not matter as the only tie the claims have to the medical imaging art is in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See MPEP 2111.02 and *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Also for an apparatus claim, an apparatus claim covers what a device is, not what it does (*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).) and must be distinguished in terms of structure rather than function. A "tissue compression membrane suited to..." is functional language therefore Williams in view of Zhang still reads over the apparatus claims 1-11. However Williams in view of Zhang does not read over the method claims as the tissue compression membrane does not do anything with minimizing image distortion.
2. As to the applicant's arguments that the claims as amended overcome the rejection in view of Galkin (US 6,850,590 B2), the examiner respectfully disagrees. The examiner believes that Galkin still reads over the claims. Even though the inflatable chamber is a comfort device, the inflatable chambers also provide a compressive force to the breast. This compression

membrane is placed in a taut condition by inflating the air chamber as can be seen in figure 9c. The compression member is also suited to minimize image distortion as it is made of material that is transparent to x-rays and does not compromise image quality (col. 8 line 39-41). Also the inflatable compression membrane can change its shape in how it is compressing the breast so that images can be retaken without repositioning the breast. This minimizes image distortion as it fixes the problem of the fact that overlapping internal structures can obscure delineation in a radiographic image (col. 9 line 40-45, col. 2 line 9-14).

3. Therefore the examiner believes the rejection dated November 16, 2007 still stands (minus the rejection of the method claims under Williams in view of Zhang) and is repeated below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-6, 8, 10, and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 4,885,827) in view of Zhang (US 2004/0090334 A1). Williams discloses an apparatus comprising a compression membrane (fig. 1 element 40) supported by a frame (figs. 1 and 2 element 30) and a plurality of tensioning apparatuses each comprising a pair of inflatable bladders (fig. 2 elements 50 and 55) also supported by the frame. The inflatable bladders are pneumatically inflated to apply a tensile force to the membrane (through tube 60 in fig. 1) in two

directions. The air pressure in each of the bladders can be adjusted depending on the size and/or shape of the tissue that is to be compressed (col. 3 line 15-32). The invention of Williams can be used in any car, such as a car that has installed a drowsiness detection system as disclosed by Zhang. The drowsiness detection system uses an imaging process to determine a driver's drowsiness level. Therefore while the driver is driving, the membrane is in the taut condition during the constant imaging process of the drowsiness detection system.

6. **Claims 1-4, and 6-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Galkin (US 6,850,590 B2). Galkin discloses an apparatus for x-ray mammography comprising a compression membrane that is stretched over a cassette holder. The membrane can comprise multiple inflatable chambers (bladders) into which a fluid, such as air can be forced into (abstract, col. 5 line 64-66, col. 7 line 1-3). As the air is being forced into the chamber, the membrane gets tauter. The membrane can accept air until it is taut and pushing against the breast as shown in figure 9c.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACQUELINE CHENG whose telephone number is (571)272-5596. The examiner can normally be reached on M-F 10:00-6:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC

/Long V Le/
Supervisory Patent Examiner, Art Unit 3768